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09/827,788	04/09/2001	Khai Hee Kwan		8886

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315 AVOCA STREET
RANDWICK, 2031
AUSTRALIA

EXAMINER

RHODE JR, ROBERT E

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/827,788

Applicant(s)

KWAN, KHAI HEE

Examiner

Rob Rhode

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

Claim 1 is objected to because of the following informalities: Some of the claim steps do not begin with a verb such as validating. Rather the applicant will either use an "if" statement or with a word such as "in" (see 6th step). For example, the applicant could have recited "requesting in the payment processor a password". Additionally, the wording of the claim 1 steps is awkward, which makes interpreting the intent as well as the meets and bounds difficult to determine.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. For example, the words used in the body of the claim such as "if both" is tentative language, which precludes the ability to determine meets and bounds of the claim. Moreover in Claim 1, the words/phrases "adjustment" and "book entry" are a relative word/phrase, which renders the claim step indefinite. The word "adjustment" and the phrase "book entry" are not defined by the claim(s), the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention. For examination purposes the word "adjustment" and the phrase "book entry" will be treated as a generic word.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant states at steps 13 and 15 of claim 1, the phrase "end user". There is insufficient antecedent basis for these limitations in the claim.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps include after step 10 of "validating the debit".

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 - 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz (US 6,424,706 B1) in view of Resnick (US 2001/0001321 A1) and further in view of Fox (US 6,560,581 B1).

Regarding claim 1 and related claim 17, Resnick teaches a computer network method for paying for goods or services over the network using telecommunication accounts through at least one telecommunication service provider and a wireless communication device such as a mobile phone comprising:

providing at least a centralized payment processor linked to the network (see at least Figure 2); in the payer telecommunication service provider's processor, upon authentication of the password or voice pattern will response as authenticated to the payment processor over the network (see at least Para 0021); verification of purchase includes the step of downloading the text message from the payer's mobile phone to the merchant's server using a wireless coupling device and the encrypted message is matched against the copy retrieved from the merchant's database (see at least Para 0033 and 34);

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conducting a payment process initiated by the payer through the payee's point of sale by validating the payer's required mobile phone number or account identifier and the payee's account identifier (see at least Para 0030); if both confirmation and authenticating steps are validated, the payer's telecommunication service provider will record a debit entry with an amount of money equal to the payer's payment amount in the monthly telecommunication bill, subject to adjustment where the payer's account is an non-prepaid telecommunication account as instructed by the payment processor over the network (see at least Para 0005);

However, Resnick does not specifically disclose a method for extending at least one the telecommunication service provider's main processor for establishing sub accounts for both payer and payee on the provider's main processor having a corresponding account identifier to the main telecommunication account such as their mobile or fixed line phone numbers where such sub accounts include personal identification such as a password or a voice pattern of the payer and payee in order to gain access; in the payment processor, upon receiving the account identifier of both payer and payee, responding with confirming the accounts with the respective telecommunication service provider's main processor over the network ; in the payment processor, upon receiving a positive response from the said to telecommunication service provider of the payer and payee, responding with an activation code sent over the network to the payer and initiating a connection to the payer's mobile phone to request the activation code to be inputted either through the keypad or by speaking the code directly to the

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microphone piece of the mobile phone so as to be validated, said response includes an indication of approval if the validating step results in identifying and confirming the transaction by assigning a unique transaction number; in the payment processor, if both confirmation and authenticating steps are validated, where the payer's account is a prepaid account, the step includes a further step of verifying the availability of funds to affect the purchase and on confirmation from the payer's telecommunication provider, the telecommunication service provider will debit an amount of money equal to the payer's payment amount, subject to adjustment as instructed by payment processor over the network; if both confirmation and authenticating steps are validated, the payer's telecommunication service provider will record a debit entry with an amount of money equal to the payer's payment amount in the monthly telecommunication bill, subject to adjustment where the payer's account is a non-prepaid telecommunication account as instructed by the payment processor over the network; if both confirmation, authenticating and debiting of the payer's account steps are validated, the payment processor will send an approval code to the payee or merchant server and instruct the merchant's telecommunication service provider where the merchant's sub account is held to record a credit entry with an amount of money equal to the payer's payment amount on the merchant's monthly telecommunication bill over the network, subject to adjustment where such credit can be cashed out only when there is a net positive cash from the total bill on settlement; at the payee or merchant's server, upon receiving this approval code, requested goods or services will be deemed sold to the payer and

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will be released according to the terms of sale over the network; at the completion of payment process, both payer and payee or merchant will receive an encrypted receipt detailing the purchase where the end-user will receive such receipt as a text message into the mobile phone's memory storage and the merchant's server upon receiving this receipt message over the network will stored this into its database.

On the other hand, Katz teaches a method for extending at least one the telecommunication service provider's main processor for establishing sub accounts for both payer and payee on the provider's main processor having a corresponding account identifier to the main telecommunication account such as their mobile or fixed line phone numbers where such sub accounts include personal identification such as a password or a voice pattern of the payer and payee in order to gain access (see at least Col 4, lines 31 – 35 and 60 – 64). Please note that Katz does disclose a password associated with a redemption password. In that regard, it would have been obvious to one of ordinary skill in the art to have a sub account with a password for the payer and payee. in the payment processor, upon receiving the account identifier of both payer and payee, responding with confirming the accounts with the respective telecommunication service provider's main processor over the network (Col 15, lines 6 – 17 and 60 – 65); in the payment processor, upon receiving a positive response from the said to telecommunication service provider of the payer and payee, responding with an activation code sent over the network to the payer and

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initiating a connection to the payer's mobile phone to request the activation code to be inputted either through the keypad or by speaking the code directly to the microphone piece of the mobile phone so as to be validated, said response includes an indication of approval if the validating step results in identifying and confirming the transaction by assigning an unique transaction number (see at least Abstract, Col 8, lines 50 – 51, Col 10, lines 11 – 14 and Col 21, lines 30 – 41); in the payment processor, if the validating step results in confirmation of the transaction, the step of requesting for a password is initiated where the payer is prompted to key in the password using the keypad or saying the password to the microphone so as to authenticate the payer's identity, authorisation and associating the accounts linkage for both payer and payee to the payment transaction (see at least Abstract and Col 4, lines 33 – 41); in the payment processor, upon receiving the password or voice pattern from the payer, this is authenticated with the stored password or voice pattern at the payer's telecommunication service provider in order to gain access to the payer's sub account over the network (see at least Col 21, lines 36 – 38); if both confirmation and authenticating steps are validated, where the payer's account is a prepaid account, the step includes a further step of verifying the availability of funds to affect the purchase and on confirmation from the payer's telecommunication provider, the telecommunication service provider will debit an amount of money equal to the payer's payment amount, subject to adjustment as instructed by payment processor over the network; if both confirmation and authenticating steps are validated, the payer's telecommunication service provider will record a

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debit entry with an amount of money equal to the payer's payment amount in the monthly telecommunication bill, subject to adjustment where the payer's account is an non-prepaid telecommunication account as instructed by the payment processor over the network (see at least Col 8, lines 24 – 29); if both confirmation, authenticating and debiting of the payer's account steps are validated, the payment processor will sent an approval code to the payee or merchant server and instruct the merchant's telecommunication service provider where the merchant's sub account is held to record a credit entry with an amount of money equal to the payer's payment amount on the merchant's monthly telecommunication bill over the network, subject to adjustment where such credit can be cashed out only when there is a net positive cash from the total bill on settlement (Col 5, lines 6 – 16 and Col 7, lines 44 – 49); at the payee or merchant's server, upon receiving this approval code, requested goods or services will be deemed sold to the payer and will be released according to the terms of sale over the network (Col 4, lines 39 – 44); at the completion of payment process, both payer and payee or merchant will receive an encrypted receipt detailing the purchase where the end-user will receive such receipt as a text message into the mobile phone's memory storage and the merchant's server upon receiving this receipt message over the network will stored this into its database (Col 10, lines 27 – 28). Please note that Katz does not specifically disclose encryption. Encryption is old and well known to one of ordinary skill in the art and thereby adding the encryption will increase security but at a

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significant increase in cost. With the increased security, the payee as well as payer trust will be enhanced.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method of Resnick with the method of Katz to have enabled method for an end to end transaction for purchasing an item using a mobile phone, telecommunications service provider and payment process as well as prepaid minutes in lieu of money. Resnick discloses a method for providing at least a centralized payment processor linked to the network; in the payer telecommunication service provider's processor, upon authentication of the password or voice pattern will response as authenticated to the payment processor over the network (see at least Para 0021); verification of purchase includes the step of downloading the text message from the payer's mobile phone to the merchant's server using a wireless coupling device and the encrypted message is matched against the copy retrieved from the merchant's database (see at least Para 0033 and 34); conducting a payment process initiated by the payer through the payee's point of sale by validating the payer's required mobile phone number or account identifier and the payee's account identifier (see at least Para 0030); if both confirmation and authenticating steps are validated, the payer's telecommunication service provider will record a debit entry with an amount of money equal to the payer's payment amount in the monthly telecommunication bill, subject to adjustment where the payer's account is an non-prepaid telecommunication account as instructed by the payment

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processor over the network (see at least Abstract, Para 0005 and Figure 2). Katz discloses an end to end transaction processing and updating method using a mobile phone and per paid minutes (Abstract, Col 4, lines 33 – 41 and Col 10, lines 10 – 15). Therefore, one of ordinary skill in the art would have been motivated to extend the method of Resnick with a method for end to end transaction processing and updating using a mobile phone and pre paid minutes.

The combination of Resnick and Katz substantially disclose the applicant's invention.

However, the combination does not specifically disclose and teach a method for providing the integrity of the receipt includes the step of uploading the encrypted receipt text message from the payer's mobile phone using the reply function to the payment processor server over the network for decryption upon which the details of the transaction will be forwarded to the merchant originating the transaction and a copy of the decrypted text message back to the end-user where such copy may be printed out by way of a wireless printer connected to the mobile phone.

On the other hand, Fox teaches a method for providing the integrity of the receipt includes the step of uploading the encrypted receipt text message from the payer's mobile phone using the reply function to the payment processor server over the network for decryption upon which the details of the transaction will be

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forwarded to the merchant originating the transaction and a copy of the decrypted text message back to the end-user where such copy may be printed out by way of a wireless printer connected to the mobile phone (see at least Abstract and Col 3, lines 29 – 34).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the combination of Resnick and Katz with the method of Fox to have enabled a method for providing the integrity of the receipt includes the step of uploading the encrypted receipt text message from the payer's mobile phone using the reply function to the payment processor server over the network for decryption upon which the details of the transaction will be forwarded to the merchant originating the transaction and a copy of the decrypted text message back to the end-user where such copy may be printed out by way of a wireless printer connected to the mobile phone. The combination of Resnick and Katz disclose a method for providing at least a centralized payment processor linked to the network and all associated claim limitations with the exception of the last step. Fox discloses a method for providing the integrity of the receipt includes the step of uploading the encrypted receipt text message from the payer's mobile phone using the reply function to the payment processor server over the network for decryption upon which the details of the transaction will be forwarded to the merchant originating the transaction and a copy of the decrypted text message back to the end-user where such copy may be printed out by way of a wireless printer connected to the mobile phone (Abstract). Therefore, one of ordinary skill

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in the art would have been motivated to extend the combination of Resnick and Katz with a method for providing the integrity of the receipt includes the step of uploading the encrypted receipt text message from the payer's mobile phone using the reply function to the payment processor server over the network for decryption upon which the details of the transaction will be forwarded to the merchant originating the transaction and a copy of the decrypted text message back to the end-user where such copy may be printed out by way of a wireless printer connected to the mobile phone.

Regarding claim 2, Katz teaches a method wherein the payment is in the form of monetary units (Col 10, lines 59 – 62).

Regarding claim 3, Katz teaches a method wherein the payment from the payer is made as a direct debit transaction in the case of a prepaid telecommunication account (Col 8, lines 24 - 28).

Regarding claim 4, Katz teaches a method wherein the payment is made from the payer as a debit book entry transaction in the case of an non prepaid telecommunication account where the payment amount is included in the billing statement where the total bill includes regular telecommunication charges (Col 10, lines 59 – 61).

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Regarding claim 5, Katz teaches a method wherein the payment is made to the merchant or payee as a credit book entry in the case of non prepaid telecommunication account and is including in the billing statement where the total may be netted off with regular telecommunication charges (Col 10, lines 58 – 62).

Regarding claim 6 and related claim 7, Resnick teaches a method wherein the purchase transaction is initiated at a point of sale by payer by connecting using internet protocol or wireless application protocol (Figure 2).

Regarding claim 8, Katz teaches a method wherein the payer and payee sub account are linked to their respective telephone or wireless telephone service account at their telecommunication service provider (Col 5, lines 6 – 17).

Regarding claim 9, Resnick teaches a method wherein the payer's account and payee or merchant's account is a prepaid telephone or wireless telephone service account linked to their sub account.

Regarding claim 10, Resnick teaches a method wherein said communicating data indicative of the payment transaction and mobile telephone account from the point-of-sale to the payment processor includes communicating the data from the point-of sale over a network to the payment processor (Para 006 and Figure 2).

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Regarding claim 11 and related claims 12, 13 and 14, method's wherein the communicating step includes responding with an activation code being sent to the point of sale over a network from the payment processor and (claim 12) wherein said communicating step includes requesting the previously sent activation code to be responded by payer either by voice or by keying into the mobile keypad upon successful connecting to the user's mobile communication device to the payment processor being sent over a network, responding with an activation code as well as a keypad are all well known in the art. In that regard, one of ordinary skill in the art would have been motivated to extend the combination of Reisman and Katz with these techniques to reduce fraud and increase security for all participants. Moreover, the communicating step(s) is only data, which is considered non-functional descriptive material. The phrase(s) and or word(s) are given little patentable weight because the claim language limitation is considered to be non-functional descriptive material, which does not patentably distinguish the applicant's invention from Resnick as well as Katz. Thereby, the non-fictional descriptive material is directed only to the content of the data being transmitted and does not affect either the structure or method/process of Resnick, which leaves the method and system unchanged.

Regarding claim 15, Katz teaches a method where upon receiving the successful authorization from the payer's carrier, payment processor will credit the payee's telecommunication sub account and debit the payer's telecommunication sub

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account, the communicating steps include sending encrypted text receipts to payer's mobile devices and payee's server over the network as confirmation (Col 10, lines 10 - 28).

Regarding claim 16, Resnick teaches a method according wherein said communicating data indicative of the transaction from the point-of-sale to the centralized payment processor; communicating a transaction message indicating the amount of the payment, the identity of the telecommunication payer account holder, the identity of the payee from the point-of-sale to the payment processor. (Abstract and Figure 2).

Regarding claim 18, Katz teaches a method and further comprising settling the payment transaction by receiving confirmation of debiting an amount of money equal to the payment amount in payer's sub account, subject to adjustment, from the payer's telecommunication service provider and a confirmation of crediting the said amount subject to adjustment, into the payee's telecommunication account by book entry from payee's telecommunication service provider (Col.

Regarding claim 19, Katz teaches a method including, in the payment processor, maintaining a database of payers' telecommunication accounts and a list telecommunication accounts of participating payees linked to each transaction unique identifier for the purposes of reconciliation and profiling of users (Col 5, lines 12 – 17).

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Regarding claim 20, Katz teaches a method and further comprising a customer interface comprising an interactive voice response module (Col 6, line 34).

Conclusion

An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Rob Rhode** whose telephone number is **(703) 305-8230**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeff Smith** can be reached on **(703) 308-3588**.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

Any response to this action should be mailed to:

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RER


Jeffrey A. Smith
Primary Examiner